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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,965	04/25/2006	Hidekazu Hoshino	127846	2790
25944 7590 06/10/2009 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER KILPATRICK, BRYAN T				
ART UNIT		PAPER NUMBER		
1797				
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06/10/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/576,965

**Applicant(s)**

HOSHINO ET AL.

**Examiner**

BRYAN T. KILPATRICK

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5506)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendments filed 26 May 2009 have been entered and fully considered.
2. The request for continued examination (RCE) filed 26 May 2009 has been entered.
3. Claims 1-11 are pending.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 May 2009 has been entered.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 7,391,546 (HOSHINO et al.).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the prior art and instant application recite a discrimination medium comprising a multilayer of cholestric layers and films, and a method of using the discrimination medium for discrimination, which similar to authentication, that employs a device having an optical filter, a light irradiation device, and a light detector. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the discrimination medium and method for the purpose of discrimination, or authentication, of a medium. The motivation would have been to provide a discrimination medium that can prevent being falsified, facilitates determining the authenticity of articles reliably, and to provide a discrimination method using the same (col. 2, lines 45-49).

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being obvious over European Patent 1,028,359 A1 (SHIOZAWA et al.).

Instant claim 1 recites a discrimination medium comprising a cholesteric liquid crystal layer having a circular polarization light selectivity and a multilayer film comprised of two sets of light transparent films separated by an interface. SHIOZAWA et al. discloses an authenticity film having circular polarized light selectivity in the Abstract, and paragraphs [0030]-[0041] disclose the use of cholesteric liquid layers and films having multiple layers. SHIOZAWA et al. discloses a plate having both right-handed and left-handed polarizing parts that are separated by a support part, and that the parts are formed by laminating a polarizing film and phase contrast film (paragraphs [0106]-[0108] and Figure 12)

SHIOZAWA et al. does not disclose a stacked multilayer film comprised of sets of light transparent films having different refraction indexes that are separated by an interface. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange the polarizing parts and the support part of SHIOZAWA et al. into a stacked or sandwich formation since it has been held that applying a known technique to a known device (method, or product) ready for improvement to yield predictable results would have been obvious to one of ordinary skill in the art at the time the invention was made. The motivation would have been to provide an authenticity identifying film having a highly esthetic design and facilitating visual authenticity identification, as disclosed in paragraph [0007]. (KSR, 550 U.S.

at \_\_\_, 82 USPQ2d at 1396; MPEP 2141 Examination Guidelines..., III. RATIONALES TO SUPPORT REJECTIONS UNDER 35 U.S.C. 103)

In addition, it would have been obvious to one of ordinary skill in the art to rearrange the polarizing parts and the support part of SHIOZAWA et al. into a stacked or sandwich formation for the purpose of improving the self-supporting ability of the medium (similarly as disclosed in Figure 1 and paragraph [0079]) since it has been held that rearranging parts of an invention involves only routine skill in the art. (*In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950); MPEP 2144.04 Legal Precedent..., VI. REVERSAL, DUPLICATION, OR REAR-RANGEMENT OF PARTS, C.

#### Rearrangement of Parts)

Instant claims 2 and 3 recite reflections of light off the cholesteric liquid crystal layer and multilayer film; approximately equal to each other in color for instant claim 2 and different from each other in color for instant claim 3, respectively. SHIOZAWA et al. discloses a method of producing a hologram (which the prior art defines as a pattern, image, or characters in the first line of paragraph [0062]) on an authenticity identifying film comprised of multiple layers: a reflective film (which has a cholesteric liquid crystal layer or phase), a protective film, a light absorbing film, and a base film in paragraphs [0046]-[0057].

Instant claim 4 requires a figure to be provided to at least a portion of one of the layer and film. Instant claim 5 requires hologram working or embossing. Instant claim 6 requires interlayer peeling structure or a peeling breaking structure. Instant claim 7

requires an article to be discriminated having the discrimination medium. Paragraph [0003] of SHIOZAWA et al. discloses the use of characters and patterns similar to the figures and characters stated by the current instant specification in paragraph [0003]. Paragraphs [0012]-[0013] of SHIOZAWA et al. disclose an embossed hologram and an authenticity identifying film attached to an article via an adhesive layer. Paragraph [0099] of SHIOZAWA et al. discloses the use of a form of peeling breaking for preventing the reuse of a discrimination medium.

Instant claims 8-11 disclose the use of a discrimination medium comprised of layers and films being analyzed by a device having an optical filter, a light irradiation device, and a light detector. The Abstract, paragraphs [0019]-[0022], and [0085]-[0091] of SHIOZAWA et al. disclose the use of these type of components in a system for authenticity identification.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRYAN T. KILPATRICK whose telephone number is

(571)270-5553. The examiner can normally be reached on Monday - Friday, 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Samuel P Siefke/  
Primary Examiner, Art Unit 1797

BK  
AU 1797